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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,638	08/28/2003	Fabio Giannetti	300203301-2	7474

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

MAIL DATE	DELIVERY MODE
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03/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,638

Applicant(s)

GIANNETTI ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 and 17-24 is/are rejected.
7) ☒ Claim(s) 16 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

1. This case has been reassigned to a new examiner.
2. In view of the appeal brief filed on 1/21/08, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 18-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claims 18-22 are directed toward a system for authoring a document. The claims, read in light of the specification, are software *per se* and do not comprise any component such as hardware or a computer-readable medium. Software *per se* is not patentable.
6. Claims 23-24 are directed toward a data structure. A data structure is software *per se* and is not patentable.

Claim Objections

7. Claim 16 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be referred to in any form other than the alternative. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. Applicant should remedy this by amending the language "a method of any one of claims 14 or claim 15" to "a method according to claim 14 or claim 15", as found in claim 3 or 20.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US 6,345,279) in view of Kraus et al. (US 6,266,684).

10. In regard to claim 1, 18, 23, Li disclosed a method of adapting content to multiple devices based upon the ability of the device to receive the content. Li, column 2, lines 28-39. Li, column 6, lines 8-29. *(defining at least two choices of content which may be styled for a first content portion of the document; defining at least two choices of content which may be styled for a second content portion of the document; labelling the choices of content for a web page to indicate to a server approved combinations of content for the first content portion of the web page with content for the second content portion of the same web page, wherein the web page is produced for serving to a requesting user by incorporating an approved combination of content for the first content portion of the web page and the second content portion of the web page.)* Li disclosed the serving of the web page, but failed to disclose the authoring of web content.

11. Kraus, in the analogous field of web pages with multiple types of content, disclosed a web authoring system allowing for multiple kinds of content to be added to a web page. Kraus, column 2, lines

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55-67. It would have been obvious to one of ordinary skill in the art at the time of invention that any web page used by Li would have to be created by some sort of programming or software, and that Kraus was a system of creating web pages that would be usable with Li in order to create the appropriate web content for Li to display.

12. In regard to claim 2, Kraus further disclosed *the step of labelling the choices of content to indicate approved combinations is performed manually by an author*. Kraus taught the insertion of web resources into a web page. Kraus, column 5, lines 31-61.

13. In regard to claim 3, 24, Li further disclosed *an additional step of arranging allowable choices into class sub-sets, each class sub-set including only those labeled choices which match properties of a class of devices on which a web document is to be rendered*. Li, column 6, lines 3-7; lines 42-48.

14. In regard to claim 4, Li further disclosed *defining more than one class sub-set of the allowable choices*. Li, column 6, lines 3-7; lines 42-48.

15. In regard to claim 5, 22, Li further disclosed *receiving properties of a device requesting a web document and selecting from a sub-class of combinations which includes a device requesting the document a set of content which matches the properties of the requesting device*. Li, column 6, lines 8-29; lines 42-48.

16. In regard to claim 6, Li further disclosed *the properties comprise physical properties of the device*. Li, column 6, lines 10-15.

17. In regard to claim 7, Li further disclosed *applying a set of rules to the content forming each combination in order to determine if the combination is allowable*. Li, column 6, lines 8-29; lines 42-48.

18. In regard to claim 8, Li further disclosed *a rule which is used comprises checking that the combination of content for the first and second portions fits within a minimum and/or a maximum area available on all of the devices within the class for rendering the content portions*. Li, column 6, lines 8-29; lines 42-48.

19. In regard to claim 9, Li further disclosed *a different rule which may be applied is to check if all of the content for the combination can be rendered by all of the defined devices within a class*. Li, column 6, lines 8-29; lines 42-48.

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20. In regard to claim 10, Li further disclosed *the class of devices comprises PDA devices, or PCs or WAP enabled devices. Li, column 6, line 18.*
21. In regard to claim 11, Kraus further disclosed *a web document which is authored comprises a web page, a portion of a web page or a set of web pages which are related to one another in some way. Kraus, column 5, lines 31-61.*
22. In regard to claim 12, Kraus further disclosed *a choice of content is provided as a separate file or a sub-file of a single file. Kraus, column 5, lines 31-61.*
23. In regard to claim 13, Kraus further disclosed *authoring new content. Kraus, column 2, lines 56-57.*
24. In regard to claim 14, Li further disclosed *providing a preference to each approved combination indicating which combination should be used in preference to another combination should more than one combination be suitable for sending to the requesting device. Li, column 6, lines 20-29; lines 42-48.*
25. In regard to claim 15, Li further disclosed *the preference is to ensure that a largest size content is always used for the given property of the requesting device. Li, column 6, lines 8-29; lines 42-48.*
26. In regard to claim 17, Li further disclosed *transmitting to the device making the request for a web document which includes one of the approved combinations included in the class-subset containing the requesting device which is best suited to that device. Li, column 6, lines 42-48.*
27. In regard to claim 19, Kraus further disclosed *the content defining tool comprises an editor which permits the author to define an identity and location of existing content choices and/or to author new content. Kraus, column 5, line 31 - column 6, line 22.*
28. In regard to claim 20, Kraus further disclosed *the labelling tool is adapted to render automatically selected choices for the author or other user and request the author or used to indicate if the combination is approved. Kraus, column 5, line 31 - column 6, line 22.*

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Claussen et al. US 6,732,330

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Wang et al.

US 6,822,663

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen
Examiner
Art Unit 2145

/J. R. S./
Examiner, Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145